

REMARKS

Applicants received a Notice of Non-Responsive Amendment mailed March 15, 2006. The sole basis for the conclusion that the amendment was non-responsive was:

The applicant's response did not detail exactly what claimed features or limitations were not found in, or obvious in view of, the prior art used in the last office action. A general statement that the steps are not disclosed is insufficient.

Applicants respectfully disagree with the Examiner's characterization of the response. The response filed in December did not constitute a 'general statement that the steps are not disclosed'. Thus, the Notice of Non-Responsive Amendment should be withdrawn.

Original claim 31 was rejected based on U.S. Pat. No. 6,749,622. Independent claim 31 was amended in the response. Specifically, claim 31 was amended as follows:

31. (Currently Amended) A method for closing an opening in tissue having an outer surface and in inner surface comprising the steps of:

introducing a self-closing clip comprising an elongated member and a pair of biasing mechanisms coupled to said member, said elongated member comprising shape memory material and having a memory set closed configuration from which it is moveable to a plurality of open configurations, said biasing mechanisms being selectively adjustable to bias the self-closing clip toward any of said plurality of open configurations, each biasing mechanism comprising a biasing member and an actuator, each biasing member adapted to apply a biasing force to said elongated member to urge said elongated member away from said closed configuration, and each actuator being coupled to one of said biasing members and adapted to activate said biasing member to apply said biasing force to said elongated member;

[[, which has ends, an open configuration and a memory set closed configuration, through the opening;]]

positioning the self-closing clip in an open configuration with said ends directed toward the inner surface of the tissue;

passing said ends through the tissue adjacent to the opening;

closing the opening; and

allowing the self-closing clip to return toward its closed configuration.

Thus, the Examiner cannot take the position that the response was merely 'a general statement that the steps are not disclosed'. As a result, applicants deny that the reply was incomplete. Applicants request reconsideration and withdraw of the non-responsive holding pursuant to MPEP Section 711.03 (a), the text of which is set forth below :

711.03 Reconsideration of Holding of Abandonment; Revival

When advised of the abandonment of his or her application, applicant may either ask for reconsideration of such holding, if he or she disagrees with it on the basis that there is no abandonment in fact; or petition for revival under 37 CFR 1.137.

711.03(a) Holding Based on Insufficiency of Reply

Applicant may deny that the reply was incomplete.

While the primary examiner has no authority to act upon an application in which no action by applicant was taken during the period for reply, he or she may reverse his or her holding as to whether or not an amendment received during such period was responsive and act on an application of such character which he or she has previously held abandoned. This is not a revival of an abandoned application but merely a holding that the application was never abandoned. See also MPEP § 714.03.

Further, with respect to the rejection under 35 U.S.C. Section 103, applicants respectfully point out that the burden is on the Examiner to provide the suggestion of the desirability of doing what the inventor has done. See MPEP 706.02(j). Consistent with the reply, applicant's respectfully submit there is no proper obviousness rejection here.

The previous Office Action took the position that there is "no allowable generic or linking claim." Applicants again respectfully disagree with the position taken in the Office

Action. It is again respectfully submitted that a generic allowable claim does exist in this case. Applicant is entitled to recapture of a reasonable number of species once a generic allowable claim is identified.

Examination and reconsideration of the application as amended previously are requested. Favorable reconsideration of the application is respectfully requested.

No fee is believed due for the submission of this response.

An information disclosure statement was filed with the last amendment.

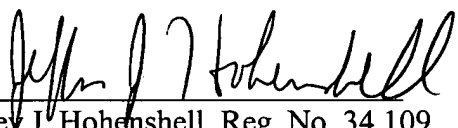
Consideration is respectfully requested.

If the Examiner comes to believe that a telephone conversation may be useful in addressing any remaining open issues in this case, the Examiner is invited to contact the undersigned attorney at 763-391-9661.

Please charge any additional required fees or credit any overpayment to Deposit Account No. 13-2546.

Respectfully submitted,

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